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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,900

06/14/2005

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2003B133A

6056

23455 7590 08/17/2009
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EXAMINER

RABAGO, ROBERTO

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. Rejection over Vandenberg '449 is withdrawn in view of argument. Provisional obviousness-type double patenting rejections over 11/628,608 and 11/728,306 are maintained.
2. The terminal disclaimer filed on 7/29/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Pat. 7,402,636 has been reviewed and is accepted. The terminal disclaimer has been recorded.
3. Regarding ODP rejections over 11/628,608 and 11/728,306, applicants' arguments filed 7/29/2009 have been fully considered, but they are not persuasive. Applicants incorrectly state that the only permissible use of the reference specification is as a dictionary. See MPEP 804 B. 1.:

Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In re Vogel, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in Vogel recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim.

As the previously cited portions of the reference specifications provide support for the claimed subject matter, those sections may also be examined in considerations of obviousness.

Regarding applicants' argument regarding domination, the presence of domination does not preclude making an obviousness-type double patenting rejection.

The analysis is described in MPEP 804 B. 1.:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).[<] In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is >anticipated by, or is merely an obvious variation of, an invention claimed in the patent? If the answer is yes, then an “obviousness-type” nonstatutory double patenting rejection may be appropriate.

A double patenting rejection of the obviousness-type, if not based on an anticipation rationale, is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Regarding applicants' argument that a provisional ODP rejection should be withdrawn if it is the sole remaining issue, this policy only applies when provisional ODP rejections exist in two applications, each over the other. Since the copending applications claim additional structure, an ODP rejection has not, and probably cannot be made in either of the copending applications over this application.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roberto Rábago/
Primary Examiner
Art Unit 1796

RR
August 14, 2009